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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,872	06/26/2003	Richard Hunter Harris	RPS920020124US1	7859
45219	7590	03/22/2006	EXAMINER	
KUNZLER & ASSOCIATES 8 EAST BROADWAY SUITE 600 SALT LAKE CITY, UT 84111			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,872

Applicant(s)

HARRIS ET AL.

Examiner

Daniel I. Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7-19 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7-19 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the RCE received on 21 Feb and the Terminal Disclaimer received on 3 January 2006.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4, 10, 18, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 4, 10, 18, and 29 it is vague/indefinite how a barcode is read (which identifies an item) but the presentation module still presents a plurality of candidate items based on the visual characteristics. Claim 1 recites that the item is identified by the coded identifier. It is unclear to the Examiner why there would be more than one candidate item if the item has already been identified by its barcode.

Appropriate clarification/correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1, 3, 5, 8, 9, 11, 13-17, 19, 21, 23-28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mergenthaler et al. (US 2004/0065740) in view of Lemelson et al. (US 5,945,656)

The Examiner notes that the independent claims recite “such that a user can detect...fraud detection” (taken from claim 1, as an example) appear to be matters of intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ 1647 (1987).

Nonetheless, the Examiner maintains that it is obvious that the prior art cited (below) can be used for fraud detection.

Re claims 1, 8, 23, 24, 27 Mergenthaler et al. teaches a processor 208, which is interpreted to execute data structures/instructions stored in memory, a reader module (100) configured to read a coded identifier associated with the item; a capture module to capture a visual (such as size/shape) characteristic of the item independent of the coded identifier (abstract); an association module configured to identify the item in a database based on the coded

identifier (using database 218); a verification module configured to verify the identity of the item based on the visual characteristic (see FIG. 5). The Examiner notes that though Mergenthaler et al. is silent to the phrase 'modules' that the Examiner has interpreted the teachings to read upon modules as means are provided with the same functionality.

Re claim 16, the limitations have been discussed above re claim 1.

Re claim 21, the Examiner interprets the capturing of visual characteristic information (size/shape) of the item as generating a visual signature.

Mergenthaler et al. teaches an error message being generated when the size and shape information doesn't match with the coded identifier, but is silent to providing audio information describing one or more visual characteristics of an item associated with the coded identifier such that a user can detect a mismatch between the coded identifier and the item to facilitate fraud detection. Re claim 13, Mergenthaler et al. teaches the database can be located in a server (220). Though silent to the server having a verification module to verify the item based on the visual characteristic, the Examiner notes that it would have been obvious to one of ordinary skill in the art to have such means completed at the server, and such teachings have been discussed in the previous Office Action as well. One would have been motivated to do this to reduce the cost of the terminals by not requiring each terminal to have such processing power, and having the processes completed at a central server, which controls and performs the processing. The use of "dummy" terminals are well known and conventional in order to save costs, for example. Re claim 14, though silent to being remote, it is well known and conventional that servers can be located remotely from a checkout, in order to be located at a central or secure facility, for

example. Re claim 15, servers are known to communicate with multiple devices (networks for example), in order to share information/resources.

The Examiner notes that it has been established in previous Office Actions, that it is known that scanning barcodes can generate item identification information, but such previous references did not teach describing a visual characteristic.

Lemelson et al. et al. teaches a presentation module presenting audio information about the item, including a visual characteristic (col 7, lines 20+).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Mergenthaler et al. with those of Lemelson et al.

One would have been motivated to do this to provide a convenient means of letting a user know if the description corresponds with the item scanned for purchase, thus providing the user with more information for their convenience, and also permitting the detection of possible fraud/errors.

Re claims 3, 17, 25, and 28 as discussed above, re FIG. 5, if the expected size and shape information match the obtained size and shape information, the scan is deemed valid, thus interpreted as confirming with a user the identity of the item, which is based on both the visual characteristic and coded identifier, as the scan is completed.

Re claims 5, 11, 19, 26, and 30 it has been discussed above (re Lemelson et al.) that a barcode can be read to determine if it is placed on the correct item, to reduce fraud, for example. Accordingly, Mergenthaler et al. teaches generation of an error message if the barcode obtained size/shape information does not match the actual size/shape obtained information. This is interpreted as a notification module to notify a user when the coded identifier does not match the

item (size/shape information does not match). Though silent to a notification module to notify matching, the Examiner notes that the completion of a transaction/scan can be broadly interpreted as notifying the user that the code is indeed associated/matches with the item it is on. Conventional scanning systems use audible tones to identify successful entering of items into a system (upon being read), and such means are conventional in the art to provide a user with information that the item has been successfully entered into the system.

Re claim 9, the limitations have been discussed above re claim 1. The Examiner notes that as a system (electronic) it would have been obvious that a processor/controller perform the steps necessary to identify the item, as is conventional in the art.

4. Claims 4, 7, 10, 12, 18, 22, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mergenthaler et al./Lemelson et al. in view of Novak.

The teachings of Mergenthaler et al./Lemelson et al. have been discussed above.

Re claims 4, 10, 18, 29 Mergenthaler et al./Lemelson et al. are silent to presenting to the user a plurality of candidate items associated with the visual characteristic and enable the user to identify the item from the plurality of candidate items. Re claims 7, 12, and 22, Mergenthaler et al./Lemelson et al. are silent to a weight module to confirm item identity based on the weight.

Re claim 4, Novak teaches such limitations (col 4, lines 60+).

Re claims 7, 12, and 22, Novak teaches a weight module (FIG. 4) to identify items, interpreted as associating weights.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the teachings of Mergenthaler et al./Lemelson et al. with those of Novak.

One would have been motivated to do this to allow selection of an appropriate item, if item identification does not succeed, or items not having records, etc., and to provide additional means to identify the item with more certainty, by using weight (measurable variable to distinguish items).

Response to Arguments

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection, as cited above.

Re the Applicants arguments re claims 1, 8, 9, 16, 21, 23, 24, and 27, the Examiner notes that the new prior art (cited above) is believed to not render the prior art unsatisfactory, and therefore such arguments are believed moot, as the new art does not teach automatically adding entries to a database when a match is not occurred. The Examiner notes that matters of the intended use included in the independent claims has been addressed in the action above. The Examiner has cited the art of Lemelson et al. to provide audible visual characteristic information, as cited above.

Re the Applicants arguments re claims 3, 4, 7, 10, 12, 17-18, 22, 25, and 29, such arguments are believed moot in light of the new art cited above.

Re the Applicants arguments re claims 5, 11, 19, 26, 28, and 30, it is noted that the features upon which applicant relies (i.e., a notification module that facilitates fraud detection) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Examiner has cited art, which is believed to notify whether a coded identifier is associated with an item, as claimed.

Re the Applicants arguments re claims 13-15, the Examiner has cited new art, rendering such arguments moot, additionally noting its well known to have a remote server process information (see Seevers et al. from the previous Office Action).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Humble (US 5,426,282 and 5,949,136), Jennings et al. (US 2002/0138374), Jacobs (US 2002/0194074), Conzola et al. (US 6,497,367), Ashby et al. (US 5,852,803), and Nambudiri et al. (US 6,640,214).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel I. Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached on M-F 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

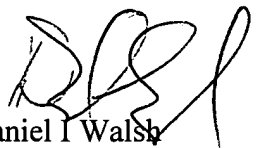
Application/Control Number: 10/608,872

Art Unit: 2876

Page 9

D. Walsh

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel I Walsh
Examiner
Art Unit 2876
3-16-06